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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,412	06/13/2006	Jae Keol Rhee	TRIUS.002NP	6355

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EXAMINER

MORRIS, PATRICIA L

ART UNIT	PAPER NUMBER
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1625

NOTIFICATION DATE	DELIVERY MODE
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08/13/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/596,412	Applicant(s) RHEE ET AL.	
	Examiner Patricia L. Morris	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-99 is/are pending in the application.
- 4a) Of the above claim(s) 53-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/1/09; 7/6/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 51 and 52 are under consideration in this application.

Claims 53-99 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

Election/Restrictions

Newly submitted claims 54-99 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly added claims 54-99 are **not readable on the originally elected process**. Claim 53 is evidence that the compounds can be made by materially different processes and does not correspond to the original claims. The elections was made **without traverse**

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 54-99 are held withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The compounds, compositions and use claims will **not be rejoined**. Rejoinder does not apply herein because applicants elected a process of making and **not the compounds**. **Note applicants' election in the response filed on March 19, 2008.**

The restriction requirement is deemed sound and proper and is hereby made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Lee et al., Chen et al., Fukuda I,II and Barbachyn et al. I,II for the reasons clearly set forth in the previous Office action.

Again, Lee et al., Chen et al., Fukuda I, II and Barbachyn et al. I, II disclose the instant processes. Lee et al. generically embrace the claimed process. Note scheme 4 wherein position 4 of the phenyl is displaced with trimethyl stannyl by reaction with hexamethylditin in the presence of a palladium catalyst whereas, Chen et al. teach an iodination reaction using N-iodosuccinimide and the reaction of the compound of formula (V) with an amino acid. Note scheme 1, lines 35-45, in column 57 and columns 111-112 therein. Fukuda I, II and Barbachyn et al. I, II teach halogenation using iodine monochloride in acetic acid or acetic acid/trifluoroacetic acid or with iodine and silver trifluoroacetate or with iodine and silver trifluoroacetate or the compound can be brominated using N-bromosuccinimide. Note column 10, lines 39-49 in column 10 or preparation 18 or last reaction in columns 29-30 of Barbachyn et

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al. II or reference example 49 of Fukuda I or reference example 22 of Fukuda II. The prior art processes of Lee et al., Fukuda et al. II and Barbachyn et al. I, II differ only in the starting material. However, Chen et al. recites that the instant alcohol of formula (II) may be used. As here, a phenyl ring is halogenated in the same position by a bromine or iodine halogenating agent and then reacted with trimethyl stannyl. The reaction of a specific phenyl compound with a halogenating agent or tin reagent does not render the process step itself patentable, *anew*; In re Albertson, 141 USPQ 730, which was specifically reaffirmed on the last page of In re Kuehl, 177 USPQ 250.

One having ordinary skill in the art would have been motivated to employ the process of the prior art with the expectation of obtaining the desired product, because he would have expected the analogous starting materials to react similarly. It has been held that application of an old process to a new and analogous material to obtain a result consistent with the teachings of the art would have been obvious to one of ordinary skill.

Applicants merely assert that they have canceled the original claims so the rejection is moot. Applicants fail to argue the rejection. All the instant steps in the claimed multi-step process are all taught by the prior art and hence, the claimed process is deemed obvious from the prior art. All the reactive sites are the same and it is expected that products will be obtained.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “convert” renders the claim indefinite and based on an inadequate or insufficient disclosure by placing no definite limits or boundaries in the claim. “Converting” does not signify that a reaction has taken place and should accordingly be changed to reacting. Moreover, the claim fails to recite how the reaction occurs. Claim 53 fails to recite the reaction conditions such as reagents, solvents, temperature, etc. What conditions are intended by applicants?

The claims measure the invention. *United Carbon Co. V. Binney & Smith Co.*, 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The C.C.P.A. in 1978 held “that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim”: *In re Priest*, 199 USPQ 11, at 15.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patricia L. Morris/
Primary Examiner, Art Unit 1625

plm
August 10, 2009